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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,667	04/22/2004	Arnold Thaler	74104.105017	6830
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King & Spalding LLP 401 Congress Avenue Suite 3200 Austin, TX 78701				
EXAMINER				
KAMAL, SHAHID				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
04/15/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

AustinUSPTO@kslaw.com

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Office Action Summary

Application No.

10/829,667

Applicant(s)

THALER, ARNOLD

Examiner

SHAHID KAMAL

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/19/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 38-42 and 48-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 38-42 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 1-20, 38-42 and 48-50 are remain pending and have been examined.
2. This Office Action is responsive to the amendment filed on January 19, 2010.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-20, 38-42 and 48-50 are rejected under 35 U.S.C. 102(e) as anticipated by Alicot et al. (US Patent No. 6,429,776 B1) ("Alicot").

5. Referring to claim 1, Alicot discloses the following:

a product configured to perform electronic functions, the product having electronic control circuits (see abstract; col. 2, lines 20-31); and

a verification and activation module coupled to the control electronic circuits of the product, wherein the verification and activation module activates the control electronic circuits of the product such that the electronic functions of the product become enabled (see col. 2, lines 32-55; col. 5, lines 21-41).

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6. Referring to claim 2, Alicot further discloses wherein the verification and activation module is removably coupled to the product (see col. 2, lines 32-55; col. 5, lines 21-41).
7. Referring to claim 3, Alicot further discloses wherein the control circuits of the product are deactivated when the verification and activation module is not coupled to the product (see col. 4, lines 13-38).
8. Referring to claim 4, Alicot further discloses wherein the verification and activation module is programmed with information (see col. 2, lines 32-55; col. 5, lines 21-41).
9. Referring to claim 5, Alicot further discloses wherein the programmed information comprises purchase date and price of the product (see col. 4, lines 1-12).
10. Referring to claim 6, Alicot further discloses wherein the programmed information comprises warranty information for the product (see col. 3, lines 21-35; col. 4, lines 1-12).
11. Referring to claim 7, Alicot further discloses wherein the programmed information comprises data about a consumer who purchased the product (see abstract).
12. Referring to claim 8, Alicot further discloses wherein the programmed information comprises data about a manufacturer of the product (see col. 2, lines 32-55; col. 5, lines 21-41).

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13. Referring to claim 9, Alicot further discloses wherein the programmed information comprises data about the product (see col. 2, lines 32-55; col. 5, lines 21-41).
14. Referring to claim 10, Alicot further discloses wherein the verification and activation module comprises a non-volatile programmable memory (see abstract).
15. Referring to claim 11, Alicot further discloses wherein the non-volatile memory is selected from the group consisting of electrically erasable and programmable read only memory (EEPROM), Flash memory and battery backed-up random access memory (RAM) (see abstract; col. 2, lines 32-55).
16. Referring to claim 12, Alicot further discloses wherein the product comprises verification and activation circuits (see col. 4, lines 39-55).
17. Referring to claim 13, Alicot further discloses wherein the verification and activation module comprises a non-volatile programmable memory, and verification and activation circuits (see col. 4, lines 39-55).
18. Referring to claim 14, Alicot further discloses a security feature that deactivates the product when outside of a geographical location (see col. 4, lines 13-38).

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19. Referring to claim 15, Alicot further discloses a security feature that deactivates the product when a security signal is not present (see col. 4, lines 13-38).

20. Referring to claim 16, Alicot further discloses wherein warranty history of the product is stored in the non-volatile memory (see col. 3, lines 21-35; col. 4, lines 1-12).

21. Referring to claim 17, Alicot further discloses wherein repair history of the product is stored in the non-volatile memory (see col. 3, lines 21-35; col. 4, lines 1-12).

22. Referring to claim 18, Alicot further discloses wherein maintenance history of the product is stored in the non-volatile memory (see abstract; col. 3, lines 21-35; col. 4, lines 1-12).

23. Referring to claim 19, Alicot further discloses a communications interface coupled to the verification and activation module (see col. 4, lines 13-38).

24. Referring to claim 20, Alicot further discloses wherein the communications interface is selected from the group consisting of WIFI and Bluetooth (see col. 5, lines 21-40).

25. Referring to claim 38, Alicot discloses the following:
an original product configured for electronic operation (see abstract; col. 2, lines 20-31);
a verification and activation module coupled to the original product (see col. 2, lines 32-55; col. 5, lines 21-41); and

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a replacement product configured for electronic operation, wherein when the verification and activation module is removed from the original product and coupled to the replacement product, the electronic operation of the replacement product is enabled and the electronic operation of the original product is disabled (see col. 2, lines 32-55; col. 5, lines 21-41).

26. Referring to claim 39, Alicot further discloses wherein once the replacement product has been enabled for operation by the verification and activation module, the original product cannot be enabled again by the verification and activation module (see col. 2, lines 32-55; col. 5, lines 21-41).

27. Referring to claim 40, Alicot discloses the following:
an original product configured for electronic operation and having a first verification and activation module (see abstract; col. 2, lines 20-31); and
a replacement product configured for electronic operation and having a second verification and activation module, wherein when the first verification and activation module is in communication with the second verification and activation module, the electronic operation of the replacement product is enabled and the electronic operation of the original product is disabled (see col. 2, lines 32-55; col. 5, lines 21-41).

28. Referring to claim 41, Alicot further discloses wherein the communication is wireless (see col. 2, lines 32-55; col. 5, lines 21-41).

29. Referring to claim 42, Alicot further discloses wherein the communication is by wire (see col. 2, lines 32-55; col. 5, lines 21-41).

30. Referring to claim 48, Alicot discloses the following:

providing an original product configured for electronic operation and having a verification and activation module (see abstract; col. 2, lines 20-31);

providing a replacement product configured for electronic operation (see col. 2, lines 32-55; col. 5, lines 21-41); and

removing the verification and activation module from the original product (see col. 2, lines 32-55; col. 5, lines 21-41); and

installing the verification and activation module in the replacement product, causing the electronic operation of the replacement product to become enabled and the electronic operation of the original product to become disabled (see col. 2, lines 32-55; col. 5, lines 21-41).

31. Referring to claim 49, Alicot discloses the following:

providing an original product configured for electronic operation and having a first verification and activation module (see col. 2, lines 32-55; col. 5, lines 21-41);

providing a replacement product configured for electronic operation and having a second verification and activation module (see col. 2, lines 32-55; col. 5, lines 21-41); and

communicating between the first and second verification and activation modules such that the electronic operation of the replacement product is enabled and the electronic operation of the original product is disabled (see col. 2, lines 32-55; col. 5, lines 21-41).

32. Referring to claim 50, Alicot discloses the following:

providing a product configured for electronic operation and having a verification and activation module (see abstract; col. 2, lines 20-31); and
communicating with the verification and activation module such that the electronic operation of the product is enabled when a correct security code is communicated to the verification and activation module (see col. 2, lines 32-55; col. 5, lines 21-41).

Response to Arguments

33. Applicant's arguments filed on January 19, 2010 have been fully considered but they are not persuasive.

34. Applicant's arguments with respect to claims 1-20, 38-42 and 48-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The examiner can normally be reached on MONDAY through THURSDAY between the hours of 8:30 AM and 7 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SK
04/07/2010

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621